

65373 U.S. PTO
03/31/97

Initial Review
BOX AF

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C. Chan
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Date of Deposit:	03/28/97	Name of Person Making the Deposit:	Margret Schreck

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Peppel

Docket No.: OOMP0001

Serial No. : 08/398,862

Art Unit: 3304

Filed: March 6, 1995

Examiner: M. O'Neill

Title: ELECTRONIC TRADING CARD

March 28, 1997

Assistant Commissioner for Patents
BOX AF
Washington, DC 20231

RECEIVED
NOV 25 2002
Technology Center 2100

AMENDMENT AFTER FINAL (37 CFR § 1.116(a))

Sir:

This is a response to the Office Action, dated January 21, 1997, for the above-identified patent application.

REMARKS

The Examiner has repeated his rejection of Claims 1-39 under 35 USC § 102(e) in view of Smith et al. Applicant is of the opinion that the Declaration Under 37 CFR § 1.131 - Tyler Peppel on September 27, 1996 is adequate in that the affidavit provides evidence of conception prior to the critical date of the cited reference along with evidence of due diligence. The Declaration indicates that as of the date of the search, Applicant had conceived of the invention. That is, the search request is evidence of conception at least before the filing date of Smith et al. The same is true for the

memorandum, which is a written record of conception, as well as the set of overlays which is also a written record of the early conception by Applicant.

Therefore, Applicant is of the opinion that conception has been established in keeping with the requirements of 37 CFR § 1.131. Further, Applicant notes that the subject patent application was filed on March 6, 1995. Applicant's search results were received on December 2, 1994. It is not unreasonable to expect the preparation of a patent application to take the interval from December 2, 1994 until March 6, 1995. Accordingly, Applicant has diligently worked toward reduction to practice, Applicant's filing of the patent application being constructive reduction to practice.

In summary, Applicant has demonstrated, by his prior filing, his conception and due diligence in reducing the invention to practice.

Applicant encloses a second declaration, Declaration Under 37 CFR § 1.131 - Tyler Peppel. It is Applicant's opinion that the information provided by the second declaration should be sufficient to overcome any reservations that the Examiner may have with regard to accepting the declaration and allowing the application to issue. Thus, it is believed that the rejection of 35 USC § 102(e) is avoided.

Respectfully Submitted,



Michael A. Glenn
Reg. No. 30,176

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Menlo Park, CA 94026
(415) 851-7138



03/31/97

C. HOS
34-897
8 Declaration

I hereby certify that this transmittal of the below described document is being deposited with the United States Postal Service in an envelope bearing First Class Postage and addressed to the Commissioner of Patents and Trademarks, Washington, D.C., 20231, on the below date of deposit.		
Date of Deposit: 03-28-97	Name of Person Making the Deposit: Margret Schreck	Signature of the Person Making the Deposit: Margret Schreck

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Peppel

Docket No.:

Serial No. : 08/398,862

Art Unit: 3304

Filed: 3/6/95

Examiner: O'Neill, M.

Title: ELECTRONIC TRADING CARD

March 24, 1997

Assistant Commissioner for Patents
Washington, DC 20231**SECOND DECLARATION UNDER 37 CFR § 1.131 - TYLER PEPPEL**

Sir:

This Declaration is provided in connection with Applicant's response to the Office Action, dated 1/21/97 for the above-identified patent application.

1. My name is Tyler Peppel. I am the inventor of the invention claimed in the subject patent application.

2. Claims 1-39 of the above-identified patent application were objected to in the above Office Action under 35 USC § 102(e) for lack of novelty. The reference cited by the Examiner as the basis for this objection was U.S. Patent No. 5,533,124, issued to Smith *et al* (the "Smith" patent). Smith issued on 2 July 1996 and was filed on 7 December 1994. Smith does not claim the same invention as that claimed in the application.

3. The subject patent application was filed on 6 March 1995, less than one year after Smith was filed.

4. The invention which is the subject matter of the application was conceived at least as early as 7 September 1994.

5. It is my practice to keep a notebook that contains my ideas and inventions. Attached hereto as an exhibit is a document that contains pages 125, 136, 137, 151, and 154 of one of my laboratory notebooks. On page 125 of my laboratory notebook is the statement "E CARD" bearing the date 9.14.94. This statement is offered as evidence of my conception of my invention prior to December 7, 1994. On page 136, there is a reference entitled, "floppy trading cards" "E CARD". This reference to my invention shows my continued work on the invention from conception. This entry is dated 9.29.94. On page 137 of my lab notebook is a diagram that shows the types of electronic cards I intend to provide as part of my invention. On page 151 of my lab notebook, the page is entitled E CARD and is dated 11.16.94. The page shows the outline I prepared for a presentation to explain my invention and work that I had done on my invention, all prior to December 7, 1994. On page 154 of my notebook, which page is dated 11.28.94, there is a reference to the expense for the patent search which was the subject of my previous declaration.

6. I searched the hard drive of my computer and printed screen shots of each search. These pages are labeled "CHRON 1" of 5 and "BANDAI -- CHRON". I printed selected documents from these searches to show early instances of my writings about electronic cards ("E CARD"). These printed pages are attached to the CHRON pages. I have added notes to these pages which key the time stamps on the CHRON pages to the individual documents (C1, C2, etc.)

I printed five screen of the CHRON pages to show the progression of the development of the invention over time, which is fairly continuous over a period of two years from September 7, 1994 to December 19, 1996. Every item on the five pages of CHRON screens pertains to my E CARD invention. I have only printed a selected few of these pages that show the earliest electronic records of my invention. It should be noted that the documents are quite old such that the font which was used to create the presentation slides is no longer available in my more recent equipment. This disrupted the formatting, but the content is still the same.

Note that the BANDAI -- CHRON file includes some early dated correspondence that mentions my E CARD invention. In particular, note a piece of e-mail from Bandai to me mentioning my invention.

5 7. I diligently worked toward the reduction to practice of the invention to which the application relates from the time of conception to at least until the submission of the subject application to the Patent Office. I continue to work on this invention to this date.

10 8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

15



TYLER PEPPEL

3.26.97

DATE

EXHIBIT TO SECOND DECLARATION OF PEPPEL

In re Application of: Peppel

Docket No.: OOMP0001

Serial No. : 08/398,862

Art Unit: 3304

Filed: March 6, 1995

Examiner: M. O'Neill

Title: ELECTRONIC TRADING CARD



03/31/97

FEG.

Simple proposal. wait for me.

MR. YAMASHITA. (CEO)

"INTERACTIVE TOY"

"E. CARD"

9.14.94.

W/SASAPANA.

transformer. → ON NETWORK.

EACH KID. CREATES. NEW
ELECTRONIC TRADING CARD.BODYFUN. CD-ROM → SEND. OCT/NOV.
20 DEVELOPERS.

1-2 MONTHS.

PIPPIN WORKSHOP. → OCT-NOV IN CUPERTINO.
20 → DEVELOPERS COMING.
C-WAVE INVITED.



03/31/97

FSG.

Simple proposal. wait for me.

mk YAMASHIMA. (CEO)
"INTERACTIVE JOY"

"E. CARD"

TRANSFORMER.

↑
FIRST
MENTION
IN NOTEBOOK

DATE

9.14.94.

W. SASAKAWA.

mk.

ET. CIV. CREATES. NEW
ELECTRONIC TRADING CARD.

Amifun. CD-ROM → SENT. OCT/NOV.
20 DEVELOPERS

1-2 MONTHS.

PIPPIN WORKSHOP → OCT-NOV IN CUPERTINO.
20 → DEVELOPERS COMING.
C- WAVE INVITED.

10/15 4-8 titles 7-py8t.

11/18/BANDAI
9, 29, 94

AUGUST TITLE DEADLINE. → THEN 2 MONTHS. LOCALIZATION.

Floppy communication → medium for kids. / PRE-NETWORK

"FLOPPY TRADING AMBS." "E-CARD" . TRADE ONLINE

3 DIFFERENT FF w/ 3 CHARACTERS. → TARGET YOUR HOMES

3 F 3 PRODUCTS → DIFFERENT CHAR ALL BANDAI

- ① 1. SAILOR MOON (EMUL.) FRANCE. ITALY. SPAIN. ALBANY
- ② 2. SAN RIO - STONE FORT INTERFACE
- ③ 3. ORIGINAL CONTENT FROM SKETCH.

DEADLINE. AUGUST. SAILOR MOON → ON MAC.

DIFFERENT FACTORY FOR EACH CHARACTER

SAME FUNCTION / DIFFERENT "AMBIENCE" FOR EACH FAC

- USER DATA VS. CD ROM DATA. / USER NAME.

- READER NEEDED? IDEALLY NO. READER SHOULD FIT ON FLOPPY.

- CONTAINER FOR HOW MANY. ①

- COMMUNICATION AMONG KIDS. / BREAK DOWN GAME CONCEPT REPAIR WITH COMMUNICATION CONCEPT

THIS CONTINUES
ON PG. 137.

CHAMPION CHOICE

MESSAGE - CHOICE

royalty. \$5 unit.
 Advance payment
 400
 250
 200
 EXCLUSIVITY. \$300K

TRADING SEASONAL BIRTH DAY INVITATION ETC.

PUZZLE GAME CARD
 LETTER

TYPES OF ELECTRONIC CARDS.

A B C D

NAME ENTRY.

BACKGROUNDFRAME

STAMP

"Trimming"

BILING
 HALLETTONET

2 FA.
 Sample

SCHEDULE

MATERIALS TO GRAVE. - NOV.

CONTRACT FINAL 12.1

MID-DEC MEETING TO DO FINANCIAL

MEETING IN SF. FOR MACHINERY:

- TO FINANCE

MID-FEB PROTOTYPE

APRIL MAY - ALPHA 25% payment

8% GM TO BANDAI/ALPHA

XMAS DEADLINE OCTOBER 5th.

Royalty \$5. - copy
 to Advance payment. 400.
 \$250. \$250.

From NAME:

- 1 - Friend to friend.
- 2 - Within family.
- 3 - print out message

Fourth Product:
 Product with
 Floppy - key.

E-CAMP

151

11.26.94

DATE

PRESENTATION
OUTLINE

PRESENTATION OUTLINE

- ① E-CAMP LOGS
- ② E-CAMP 25 WORDS or LESS DESCRIPTION (CONCEPT)
- ③ ~~THE~~ THE WORDS OF E-CAMP
- ④ E-CAMP GENERATION.
- USE SLIDE
- ⑤ CAMP EXCHANGE.
- USE SLIDE
- ⑥ CAMP COLLECTING/ORGANIZATION.
- USE SLIDE
- ⑦ CAMP ACTIVITIES.
- USE SLIDE
- ⑧ "LOCK AND KEY"
- ⑨ LEGAL ISSUES.
- ⑩ ~~PERSONAL (OR OTHER) (FROM OTHER SITES?)~~
- ⑪ THE E-CAMP ENGINE.
- ⑫ PARTNERSHIP PROPOSAL.
- ⑬ ~~PROPOSED SCHEDULE~~

154

11.28.94.

NEWCO EXPENSE.

\$500 to Howard Rice for E-CARD
PATENT SEARCH

→ (TMA) Agreement confirm note.

→ GOLF STUFF for BENKESS

→ CALL LIP.

←
MENTION OF

Items Found

Name

Size Kind

Last Modified

<input type="checkbox"/> E-Card Markets	33K	document	12/1/94	8:08
<input type="checkbox"/> E-Card Newco	33K	document	12/1/94	8:08
<input type="checkbox"/> E-Card Newco	33K	document	12/1/94	8:08
<input type="checkbox"/> E-Card Newco	33K	document	12/1/94	8:08
<input type="checkbox"/> e-card big picture / bandai	33K	document	12/1/94	7:40
<input type="checkbox"/> e-card big picture / bandai	33K	document	12/1/94	7:40
<input type="checkbox"/> e-card big picture / bandai	33K	document	12/1/94	7:40
<input type="checkbox"/> e-card is	33K	document	12/1/94	7:07
<input type="checkbox"/> e-card is	33K	document	12/1/94	7:07
<input type="checkbox"/> E-Card proposal/carmel	16K	Microsoft Word document	11/10/94	8:23
<input type="checkbox"/> E-Card Licensing = C8	33K	document	9/7/94	7:35
<input type="checkbox"/> Selling E-Cards	33K	document	9/7/94	7:09
<input type="checkbox"/> E-Card security	33K	document	9/7/94	6:56
<input type="checkbox"/> making an E-Card	33K	document	9/7/94	6:36
<input type="checkbox"/> inside an e-card = C4	33K	document	9/7/94	6:02
<input type="checkbox"/> e-cards can link = C3	33K	document	9/7/94	5:30
<input type="checkbox"/> e-cards contain = C2	33K	document	9/7/94	5:08
<input type="checkbox"/> e-cards are = C1	33K	document	9/7/94	4:59

EARLIEST ELECTRONIC DOCUMENTS

Found 90 Items

Trash

CHRON 1 = 9/7/94 - 12/1/94
 CHRON 2 = 12/1/94 - 2/16/95
 CHRON 3 = 2/16/95 - 2/23/95
 CHRON 4 = 2/23/95 - 5/13/96

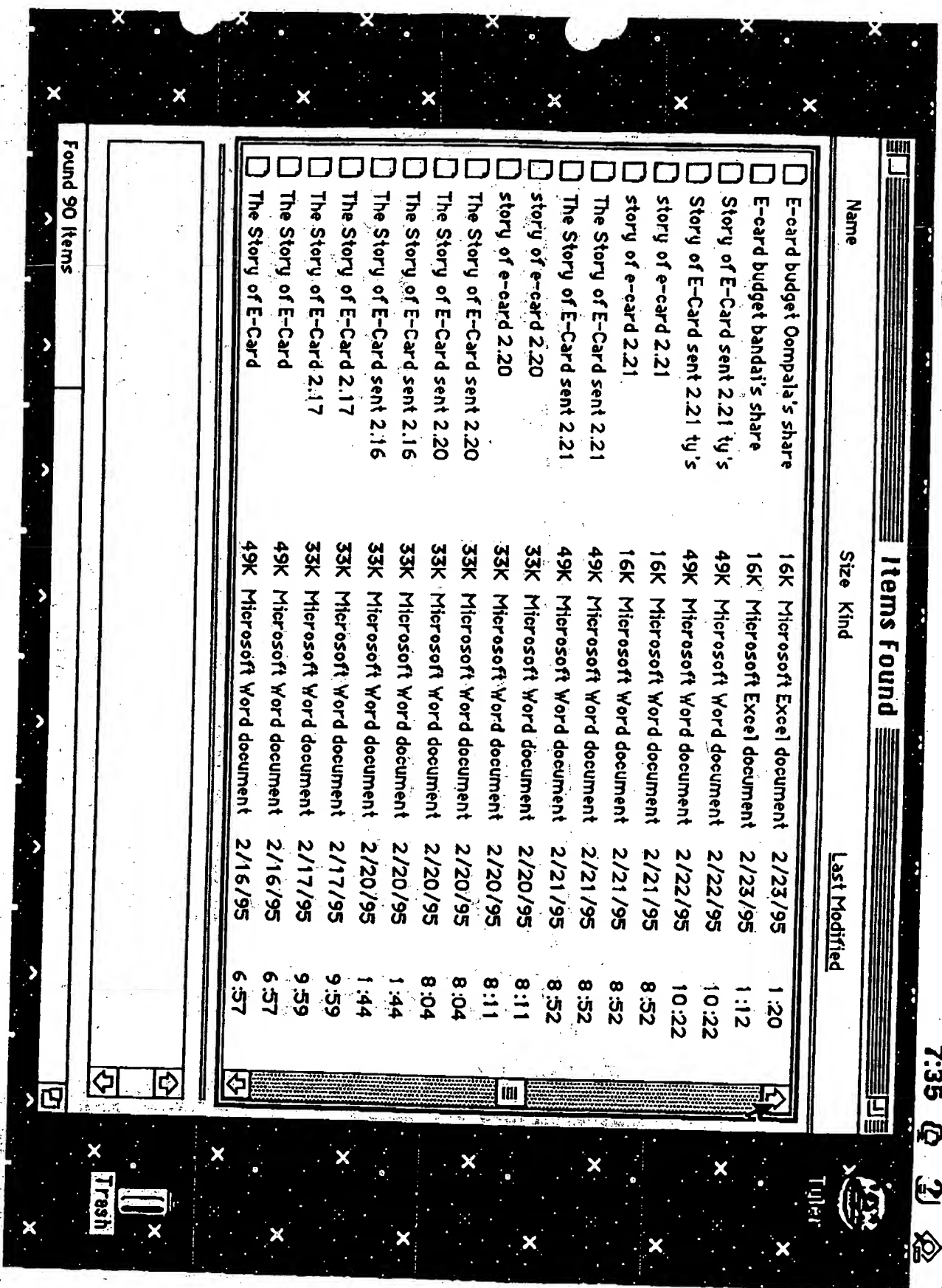
CHRON 5 = 5/13/96 - 12/19/96

"CHRON 1" of 5

Items Found			
Name	Size	Kind	Last Modified
<input type="checkbox"/> The Story of E-Card	49K	Microsoft Word document	2/16/95 6:57
<input type="checkbox"/> e-card job posting	33K	document	1/31/95 8:48
<input type="checkbox"/> E-card budget	16K	Microsoft Excel document	1/26/95 8:58
<input type="checkbox"/> frank/e-card	33K	document	1/19/95 11:01
<input type="checkbox"/> frank/e-card	33K	document	1/19/95 11:01
<input type="checkbox"/> E-Card lead eng job des. 12.19.	16K	Microsoft Word document	12/19/94 1:57
<input type="checkbox"/> e-card big picture	33K	document	12/4/94 7:21
<input type="checkbox"/> e-card big picture	33K	document	12/4/94 7:21
<input type="checkbox"/> e-card cover/logo	33K	Adobe Illustrator 5.0 d...	12/4/94 6:50
<input type="checkbox"/> e-card cover/logo	33K	Adobe Illustrator 5.0 d...	12/4/94 6:50
<input type="checkbox"/> e-card scenario labels	33K	Adobe Illustrator 5.0 d...	12/4/94 5:21
<input type="checkbox"/> captions for E-Card storyboards	16K	Microsoft Word document	12/4/94 4:54
<input type="checkbox"/> E-Card Exclusivity	33K	document	12/1/94 8:08
<input type="checkbox"/> E-Card Exclusivity	33K	document	12/1/94 8:08
<input type="checkbox"/> E-Card Exclusivity	33K	document	12/1/94 8:08
<input type="checkbox"/> E-Card legal	33K	document	12/1/94 8:08
<input type="checkbox"/> E-Card legal	33K	document	12/1/94 8:08
<input type="checkbox"/> E-Card legal	33K	document	12/1/94 8:08

C2-13

Found 90 items



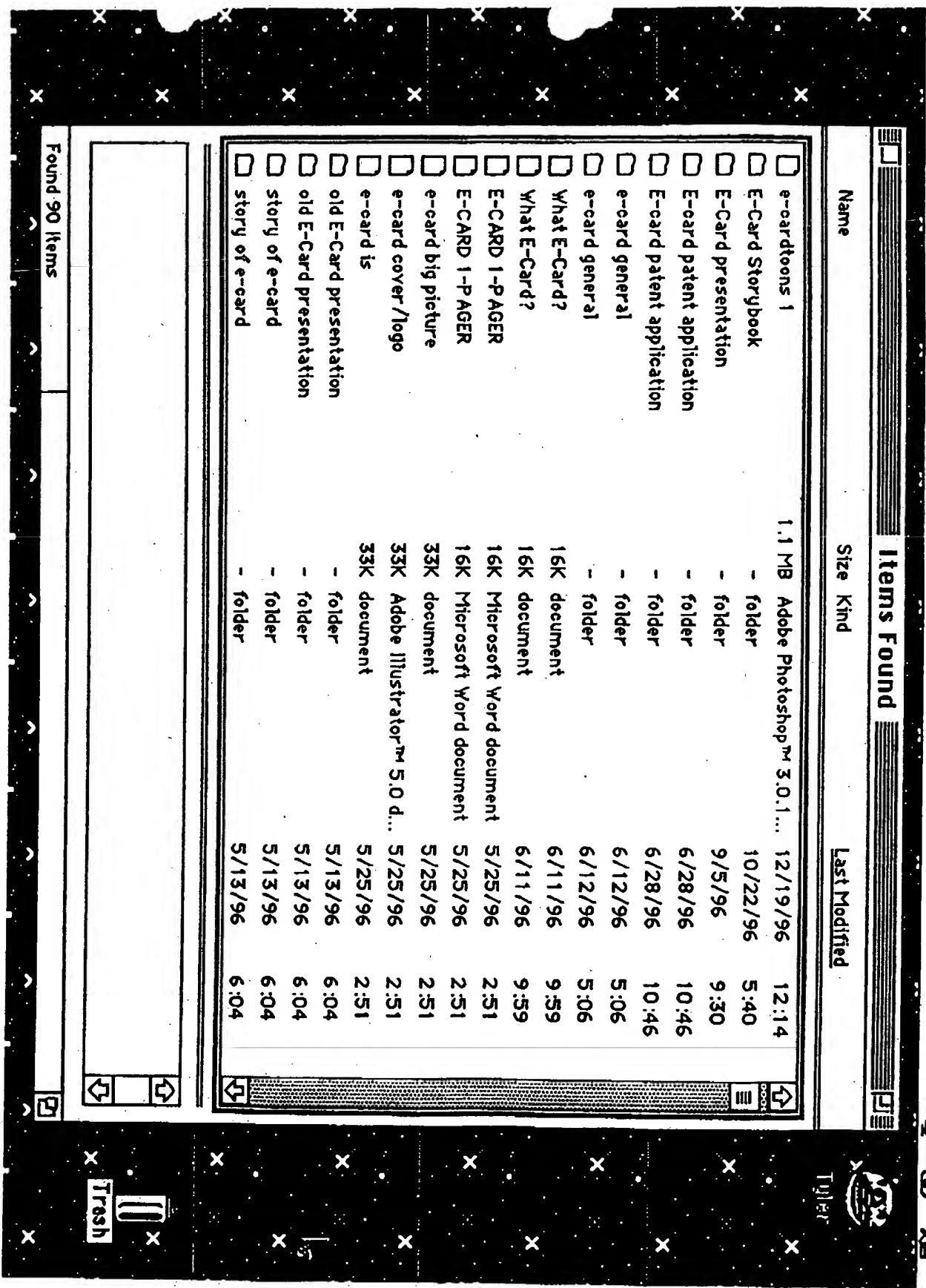
CHRON 3 of 5

Items Found			
Name	Size	Kind	Last Modified
<input type="checkbox"/> story of e-card	-	folder	5/13/96 6:04
<input type="checkbox"/> E-card backgrounder	16K	Microsoft Word document	3/5/96 2:17
<input type="checkbox"/> AOL - E-Card Terms	16K	Microsoft Word document	12/13/95 8:51
<input type="checkbox"/> GUNDAM E-CARD.1	49K	Inspiration® 4.1a PPC d...	11/10/95 11:43
<input type="checkbox"/> e-card lead engineer / 10.95	16K	Microsoft Word document	10/11/95 11:24
<input type="checkbox"/> E-Cardnames	16K	Microsoft Word document	8/6/95 9:07
<input type="checkbox"/> E-Card Backgrounder.txt	16K	Microsoft Word document	5/23/95 2:23
<input type="checkbox"/> E-Card Backgrounder.txt	16K	Microsoft Word document	5/23/95 2:23
<input type="checkbox"/> E-CARD ENGINE.PICT	33K	document	5/6/95 4:50
<input type="checkbox"/> E-CARD ENGINE.PICT	33K	document	5/6/95 4:50
<input type="checkbox"/> E-Card Data Field Layout	33K	Adobe Illustrator™ 5.0 d...	5/1/95 7:07
<input type="checkbox"/> E-Card Data Field Layout	33K	Adobe Illustrator™ 5.0 d...	5/1/95 7:07
<input type="checkbox"/> e-card on line schedule	66K	Adobe Illustrator™ 5.0 d...	4/2/95 1:57
<input type="checkbox"/> e-card engine V 3.6.95	16K	Microsoft Word document	3/5/95 3:52
<input type="checkbox"/> e-card engine (from Paul)	16K	Microsoft Word document	3/5/95 3:51
<input type="checkbox"/> e-card to write	16K	Microsoft Word document	2/25/95 11:01
<input type="checkbox"/> e-card to write	16K	Microsoft Word document	2/25/95 11:01
<input type="checkbox"/> E-card budget Oompala's share	16K	Microsoft Excel document	2/23/95 1:20

Found 90 items

Trash

CHRON 465



CHRON 545

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